

REMARKS

Claims 1-28 are pending in the case. The Examiner rejected claims 1-2, 13-14, and 17-18 under 35 U.S.C. §102(e) as being unpatentable in view of U.S. Patent No. 5,933,822 to Braden-Harder (hereinafter "Braden-Harder"). The Examiner rejected claims 3, 8, 15, 19, and 24 under 35 U.S.C. §103(a) as being unpatentable in view of Braden-Harder and U.S. Patent No. 5,675,819 to Schuetze (hereinafter "Schuetze"). The Examiner rejected claims 4-7, 9, 16, 20-23, 25, and the various multiple dependent combinations under 35 U.S.C. §103(a) in view of Braden-Harder and U.S. Patent Publication No. 2002/0156763 to Marchisio (hereinafter "Marchisio"). The Examiner rejected claims 10-11 and 26-27 under 35 U.S.C. §103(a) in view of Braden-Harder and U.S. Patent No. 5,696,962 to Kupiec (hereinafter "Kupiec"). The Examiner rejected claims 9/11, 24/27, and 25/27 under 35 U.S.C. §103(a) in view of Braden-Harder, Schuetze, Marchisio, and Kupiec. The Examiner rejected claims 12 and 28 under 35 U.S.C. §103(a) as being unpatentable in view of Braden-Harder and U.S. Patent No. 6,014,664 to Fagin et al. (hereinafter "Fagin"). In addition, the Examiner objected to the drawings, abstract, and claim 16 for informalities.

Applicant has amended claims 1, 2, 13, 14, 16, 17, and 18. Applicant has cancelled claims 8-11 and 24-27. New claims 29-32 were added. All changes were made without adding any new matter. The pending claims as amended are believed to be in condition for allowance, and applicant respectfully requests the prompt allowance of claims 1-7, 12-23, and 28-32.

DRAWING OBJECTION

The Examiner objected to the drawings based on the draftsman's objection under 37 CFR 1.84(l). Applicant is filing herewith a request to submit substitute drawings. Applicant has clarified the numbering and lines in the original figures. No new matter was added. Applicant respectfully submits that the substitute drawings are in acceptable format.

ABSTRACT OBJECTION

The Examiner objected to the language and length of the Abstract. Applicant has made a proper correction of the Abstract.

REJECTION OF CLAIMS 1-2, 13-14, AND 17-18 UNDER 35 U.S.C. §102(e)

The Examiner rejected claims 1-2, 13-14, and 17-18 under 35 USC §102(e) in view of Braden-Harder. Applicant has amended claims 1-2, 13-14, and 17-18. Specifically, Applicant has included elements such as “presenting the context information to a user” and “gathering user preferences for the context information” which were originally in claim 8 and other similar claims. As indicated by the Examiner, these elements are not taught or suggested by Braden-Harder. Therefore, Applicant respectfully submits that these amended claims as well as all dependent claims are allowable over the rejection under 35 U.S.C. §102(e).

It is well settled that under 35 U.S.C. §102 “an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant finds no suggestion or teaching in Braden-Harder of “presenting the context information to a user” and/or “gathering user preferences for the context information.” Furthermore, the Examiner has offered no evidence of such teachings in Braden-Harder. Therefore, Applicant respectfully submits that these amended claims, as well as all dependent claims are patentable over Braden-Harder under 35 U.S.C. §102(e).

REJECTION OF CLAIMS 3, 8, 15, 19, and 24 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 3, 8, 15, 19, and 24 under 35 U.S.C. §103(a) in view of Braden-Harder and Schuetze. Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. *See id.*

Applicant respectfully asserts that Braden-Harder and Schuetze fail to teach or suggest all the claim limitations of the amended independent claims 1, 13, and 17. Specifically, the references fail to teach or disclose “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences” as recited in the amended independent claims. These elements or other similar elements were originally in claims 8, 9, 10, 24, 25, and 26. The references fail to teach or disclose involving a user in the ranking or re-ranking of documents in a result set.

The Examiner relies heavily on Braden-Harder to reject independent claims 1, 13, and 17 under 35 U.S.C §102(e) and then relies on this argument in support of a rejection of claims 3, 8, 15, 19, and 24 without specifically providing evidence of teachings or suggestions of “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences” in Braden-Harder or Schuetze. Instead, the Examiner relies on Schuetze as evidence of extracting lexical affinities from the documents.

Applicant finds no teaching or suggestion in Braden-Harder or Schuetze regarding “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences.”

Because the Examiner has failed to provide any evidence of the elements of “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences” in Braden-Harder or Schuetze and Applicant has found no such evidence, Applicant respectfully asserts that claims 3, 8, 15, 19, and 24 are allowable.

REJECTION OF CLAIMS 4-7, 9-12, 16, 18, AND 20-28 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 4-7, 9, 16, 20-23, 25, and the various multiple dependent combinations under 35 U.S.C. §103(a) in view of Braden-Harder and Marchisio. The Examiner rejected claims 10-11 and 26-27 under 35 U.S.C. §103(a) in view of Braden-Harder and Kupiec. The Examiner rejected claims 9/11, 24/27, and 25/27 under 35 U.S.C. §103(a) in view of Braden-Harder, Schuetze, Marchisio, and Kupiec. The Examiner rejected claims 12 and 28 under 35 U.S.C. §103(a) as being unpatentable in view of Braden-Harder and Fagin. Applicant respectfully traverses these rejections.

As described above, establishing a *prima facie* case of obviousness requires that the combination of the prior art references teach or suggest all the claim limitations. *See* MPEP § 2142. Specifically, the limitations of “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences” as in the amended independent claims 1, 13, and 17 are missing from Braden-Harder as well as all the other references of record. As discussed above, the Examiner has presented no evidence of teaching or suggestion for these elements nor has the Applicant found such evidence. Therefore, Applicant asserts that independent claims 4-7, 9-12, 16, 18, and 20-28 and all claimed multiple dependencies are allowable over the art of record because these elements are not taught or suggested in the art of record.

The elements of “presenting the context information to a user,” “gathering user preferences for the context information,” and “ranking the documents, based at least in part on the user preferences” represent a distinction over the prior art of record. Specifically, these elements comprise user-feedback in ranking and re-ranking of the documents.

Braden-Harder teaches generation of logical forms for documents in the result set of a word-relation-word format. Braden-Harder also teaches generation of logical forms for the user query. Then, Braden-Harder compares logical forms in the result set documents to those of the user query to filter and/or rank or re-rank the documents. Schuetze teaches a similar process of comparing word vectors in the result set documents with word vectors in the query.

The Applicant has recognized a problem with these approaches. *See* Specification page 4, lines 9-18. Typically, the query is very short and consequently offers little to filtering and ranking operations as performed in Braden-Harder and Schuetze. The Applicant has addressed this problem by involving the user in the ranking and re-ranking of the documents. In addition, contextual information drawn from the documents is used to efficiently rank, weight, and re-rank documents in the result set.

The other references of Schuetze, Marchisio, Kupiec, and Fagin also fail to teach or disclose the distinguishing limitations of “presenting the context information to a user,” “gathering user preferences for the context information,” or “ranking the documents, based at least in part on the user preferences.” Therefore, Applicant asserts that claims 4-7, 9-12, 16, 18, and 20-28 are allowable 35 U.S.C. §103(a) over the prior art of record.

Finally, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. *See* MPEP § 2142. This suggestion or motivation to combine references must be established by factual findings. “The factual inquiry whether to combine references must be thorough and searching. (quoting *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)) It must be based on objective evidence of record.” *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Furthermore, “[an] examiner’s conclusory statements that [the court quotes the conclusory statements] do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability...” *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Applicant asserts that because the Examiner has not provided evidence of teaching or suggestion of gathering and using information from the user to rank and re-rank the documents, the Examiner has also failed to provide evidence of why one of skill in the art would select the prior art references or combine them. Therefore, this further supports Applicant’s assertion that claims 4-7, 9-12, 16, 18, and 20-28 are allowable 35 U.S.C. §103(a) over the prior art of record.

New Claims 29-32

Applicants have added new claims 29-32 in an effort to receive the full benefit of the filing fee paid. These new claims depend from amended claims 1, 13, and 17. These new claims add no new matter and are allowable for at least the same reasons as claims 1, 13, and 17 discussed above.

In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. In the event any questions or issues remain that can be resolved with a phone call, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "David J. McKenzie", is written over a horizontal line.

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